

REMARKS

Claims 2-4, 9-16 and 23 are all the claims pending in the present application.

Initially, Applicants thank the Examiner for indicating that claims 19 and 21-22 are allowable.

On page 2 of the Office Action, claims 2-4, 9-16 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicants respectfully respond as follows.

Initially, it is noted that the Examiner does not state any reasons or basis as to why the claims are indefinite. However, the Examiner does indicate that claims 10-12 and 13-15 are substantial duplicates, and that claims 16 and 23 are substantial duplicates. This appears to be a criticism under 37 C.F.R. § 1.75.

It is respectfully submitted that claims 10-12 are directed to a method for producing a second optical isomer (optical isomer II) from a first optical isomer (optical isomer I) by reacting a biological material with optical isomer I to convert it to optical isomer II. The method includes an isolating step for isolating optical isomer II. Claims 13-15 are directed to a method for improving the optical purity of an amino acid of Formula (1) by reacting it with a biological material to convert an optical isomer I to an optical isomer II. In addition, claims 10-12 and claim 16 requires an isolation step whereas claims 13-15 and 23 do not.

Therefore, claims 10-12 and claims 13-15 are not substantial duplicates of each other, and claim 16 and claim 23 are not substantial duplicates of each other. In

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No.: 09/537,416

Attorney Docket No.: Q58481

addition, it is respectfully submitted that claims 19 and 21-22 should be allowed in their present form because claim 16 is not a substantial duplicate of claim 23.


In conclusion, the rejection/objection should be overcome, and in view of the above, it is respectfully submitted that the claims are in condition for allowance.

Reconsideration and withdrawal of the rejection is respectfully requested, and allowance of claims 2-4, 9-16 and 23 are respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Keiko K. Takagi  
Registration No. 47,121

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: September 15, 2003 (timely filed since September 13, 2003 is a Saturday)